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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,915	07/22/2003	D. Russell Pflueger	D-3077	7109
33197 7590 06/01/2007 STOUT, UXA, BUYAN & MULLINS LLP 4 VENTURE, SUITE 300 IRVINE, CA 92618			EXAMINER PATEL, NIHIR B	
			ART UNIT 3772	PAPER NUMBER
			MAIL DATE 06/01/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/624,915

Applicant(s)

PFLUEGER ET AL.

Examiner

Nihir Patel

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3772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03.13.2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 52-55, 66-68, 70-78 and 80-92 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 52-55, 66-68, 70-78 and 80-92 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 21st, 2007 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims **52-55, 66-68, 70-78 and 80-92** have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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5. Claims **52-55, 66-68, 70-78 and 80-92** are rejected under 35 U.S.C. 103(a) as being unpatentable over Metzger et al. (US 2003/0149488) in view of Conrad et al. (US 6,523,543).

6. **As to claim 82**, Metzger substantially teaches a stiffening pharyngeal wall treatment that comprises an appliance **110** comprising two elongated curved element, each of the curved elements having a substantially circular dimension between a first end and a second end extending through more than 90 degrees of a circle (see **figures 6 and 7, pages 3 and 4 paragraphs [0041], [0042] and [0043]**; the plurality of braids makeup the two elongated elements), the two elements being coupled together at respective first and second ends (see **page 4 paragraph [0043]**), and being spaced apart from each other between the first and second ends, the appliance being sized and structured to be placed in or radially outwardly from the lateral and posterior walls of an oropharyngeal region of a human or animal with the length of at least one of the elongated elements extending generally laterally across the posterior wall and when so placed, being effective in treating sleep apnea (see **figures 6 and 7 and page 3 paragraphs [0031], [0032] and [0041]**), but does not disclose the curved elements being made of a biocompatible metal. Conrad teaches an apparatus that does disclose an apparatus that is made of a biocompatible metal (see **column 4 lines 62-67**). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Metzger's invention by designing the curved elements from a biocompatible material as taught by Conrad in order to encourage tissue in-growth to secure the device in place.

7. **As to claim 83**, Metzger substantially teaches an apparatus wherein the substantially circular dimension between the first and the second ends extend through at least 180 degrees of a circle (see **figures 6 and 7**).

8. **As to claim 84**, Metzger substantially teaches an apparatus wherein the appliance includes only two elongated curved elements, each of the curved elements has a curved length extending from the first end to the second end, and the first end and the second end define a gap therebetween extending outwardly away from the first and second curved elements having a gap length which is reduced relative to the curved length of each of the curved elements (**see figures 6 and 7**).

9. **As to claim 85**, Metzger substantially teaches an apparatus wherein each of the two elongated elements comprise a resilient wire (**see page 4 paragraph [0043]**).

10. **As to claim 86**, Metzger substantially teaches an apparatus wherein the appliance comprises a C-shaped structure (**see figures 6 and 7**).

11. **As to claim 87**, Metzger substantially teaches an apparatus wherein the two elongated elements are portions of the same structure (**see figures 6 and 7**).

12. **As to claim 88**, Metzger substantially teaches an apparatus wherein the appliance has a lateral dimension defined by the distance between the first and second ends and a maximum longitudinal dimension perpendicular to the lateral dimension which is less than the lateral dimension (**see figures 6 and 7**).

13. **As to claim 89**, Metzger substantially teaches an apparatus wherein the appliance has a concave loop configuration when the appliance is so placed in the oropharyngeal region (**see figures 6 and 7**).

14. **As to claim 90**, Metzger substantially teaches an apparatus wherein the appliance is sized and structured to be placed below a soft palate of a human or animal (**see figures 6 and 7 and page 3 paragraphs [0031], [0032] and [0041]**).

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15. **As to claim 91**, Metzger substantially discloses the claimed invention, see rejection of claim 82 above, but does not disclose the appliance being made of an elastic spring memory material. Conrad teaches an apparatus that does disclose the appliance being made of an elastic spring memory material (**see column 5 lines 55-65**). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Metzger's invention by providing an appliance being made of an elastic spring memory material in order to resist deflection due to airflow.

16. **As to claim 92**, Metzger substantially discloses the claimed invention, see rejection of claim 82 above, but does not disclose the appliance being made of nitinol. Conrad teaches an apparatus that does disclose the appliance being made of nitinol (**see column 7 lines 15-25**). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Metzger's invention by providing an appliance being made of nitinol in order to resist deflection due to airflow.

17. **As to claims 52-55, 66-68, 70-78, 80 and 81**, Metzger substantially teaches a stiffening pharyngeal wall treatment that comprises method steps of providing an appliance **110** that is placed below a soft palate of a human or an animal (**see figures 6 and 7 and page 3 paragraphs [0031], [0032] and [0041]**) in or radially outwardly from the lateral and posterior walls of an oropharyngeal region of the human or animal, the appliance so provided having at least two laterally positioned elements substantially longitudinally spaced apart from each other (**see figures 6 and 7, pages 3 and 4 paragraphs [0041], [0042] and [0043]; the plurality of braids makeup the two elongated elements**) and being effective in treating sleep apnea, but does not disclose the curved elements being made of a biocompatible metal. Conrad teaches an apparatus

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that does disclose an apparatus that is made of a biocompatible metal (see column 4 lines 62-67). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Metzger's invention by designing the curved elements from a biocompatible material as taught by Conrad in order to encourage tissue in-growth to secure the device in place.

The method steps would have been obvious because they would have resulted from the use of the device of Metzger and Conrad.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nihir Patel whose telephone number is (571) 272-4803. The examiner can normally be reached on 7:30 to 4:30 every other Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on (571) 272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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